



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,295	02/18/2002	Gregory Schlottmann	405530	3356

7590

11/19/2003

George H. Gerstman
Suite 4200
55 East Monroe Street
Chicago, IL 60603-5803

EXAMINER

HARRISON, JESSICA

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 11/19/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/078,295

Applicant(s)

SCHLOTTMANN ET AL.

Examiner

Jessica J. Harrison

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-16 is/are allowed.
- 6) ☒ Claim(s) 1-12, 17- 42 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 is dependent upon itself. Dependency from claim 10 has been assumed for examination purposes.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3, 5-8, 10-12, 17-20, 22-24, 26-31 and 38 – 42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the claims are directed to pre-emption of a mathematical algorithm, as they are not limited to a practical application. If the “acts” of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. In practical terms, claims define non-statutory processes if they consist solely of mathematical operations without some claimed practical application. A claimed process that consists solely of

mathematical operations is non-statutory whether or not it is performed on a computer. Furthermore, intended use or field of use statements, necessary antecedent steps to performance of a mathematical operation (data gathering or data definition) and post mathematical operation steps using solution or merely conveying result of operation (insignificant post-solution activity such as displaying that which has been calculated) can not serve to convert a claim to statutory subject matter. For example, claim 1 defines a field of use in the preamble, mathematical operations in the “establishing a software mathematical model” and “running the set through the model” steps, data gathering in the “establishing a range” and “randomly selecting” steps, and post-solution activity in the “displaying simulated movement” step. No practical application is seen recited in the claim leaving the claims directed to non-statutory subject matter. A similar analysis can be performed on each rejected claim listed above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

Art Unit: 3714

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 5-7, 9, 17-19, 21-28 and 30 – 42, as best understood are rejected under 35 U.S.C. 102(e) as being anticipated by Vancura . The published application to Vancura carries priority to September 8, 2000 and teaches a method for playing a primary or bonus game in a gaming machine. The method includes establishing a plurality of paths, randomly traversing the paths and awarding the player values associated with the squares landed upon. Vancura teaches that the expected value of each path is calculated using combinatorial analysis or a Monte Carlo simulation of the game. Through simulations of the game, the paytables can be established and the overall expected value of the game be known to be acceptable to the operator. Vancura indicates that these types of mathematical analyses are well known to skilled artisans. The reference is deemed to meet the method as broadly claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3 ,8, 10, 11, 20 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vancura in view of Tracey.

While Vancura cites several examples of what may be simulated by his game and method, he fails to explicitly state such could be used to simulate the game of pachinko. Tracey has been cited to illustrate that it is known to program a simulation of the game of pachinko, and to establish spin/directional parameters to the balls. Clearly, Tracy has been programmed and simulates a pachinko game. As pachinko is a game where an object (ball) traverses a random path, such as that suggested in Vancura, it would have been obvious to one of ordinary skill in the art at the time of the invention to simulate pachinko in the Vancura method. Doing such would have rendered the data gathered to be specific to a ball or plurality of balls and their characteristics as they randomly traversed a path. Such would have provided a popular implementation of the Vancura teaching.

Allowable Subject Matter

Claims 13 – 16 are allowed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional art relates to a method of programming a pachinko simulation and to a paytable that varies during play.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica J. Harrison whose telephone

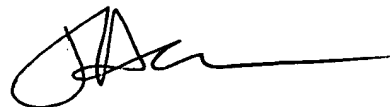
Application/Control Number: 10/078,295
Art Unit: 3714

Page 6

number is 703-308-2217. The examiner can normally be reached on 8
hour/M-F.

If attempts to reach the examiner by telephone are unsuccessful, the
examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax
phone number for the organization where this application or proceeding is
assigned is 703-872-9302.

Any inquiry of a general nature or relating to the status of this
application or proceeding should be directed to the receptionist whose
telephone number is 703-308-0858.



Jessica J. Harrison
Primary Examiner
Art Unit 3714

jjh